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LYON & HARR, LLP 300 ESPLANADE DRIVE, SUITE 800 OXNARD, CA 93036			CHEN, CHONGSHAN	
			ART UNIT	PAPER NUMBER
			2172	
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9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/681,183

Applicant(s)

CAPPS, STEPHAN P.

Examiner

Chongshan Chen

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed on 20 January 2004 have been fully considered but they are not persuasive.
2. As per applicant's arguments regarding Appelt does not teach automatically identify one or more person and automatically retrieve information have been considered but are not persuasive. Applicant agrees that Appelt teaches identify one or more person through parsing of electronic documents and retrieve data relating to one or more person through a manual user query on page 3 of the argument. The teaching of Appelt is done by a computer system, where as, the parser parses electronic document to identify people and the system provides a search function to retrieve information related to the person is equivalent to Applicant's identifying one or more person and retrieving information related to the person. However, Applicant claims that identifying and retrieving are done automatically. Examiner wants to point out a case law, which teaches that an automatic means to replace a manual activity is not sufficient. See *In re Vener*.

*In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed."

**The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.**

Art Unit: 2172

3. As per applicant's arguments regarding claim 2, 25 and 35, Appelt does not disclose automatically providing communication access point related to the retrieved information, have been considered but are not persuasive. The applicants define communication access points as including, for example, an email address, ..., a physical address, or any other means or method of communication with, or access to, the person. The system of Appelt parses electronic document and identifies people and location (Appelt, col. 9, lines 16-21). The location is an access point related to the person. A user can use the location information to contact the person.

4. As per applicant's arguments regarding claim 7-8, Appelt does not disclose a capability to identify graphical data, have been considered but are not persuasive. Appelt teaches the system can capture data from a multimedia source (Appelt, col. 5, lines 13-15). The multimedia source inherently includes graphical data.

5. As per applicant's arguments regarding claim 24 and 37, Appelt does not disclose directly scan the display device itself to identify information being rendered on that display device, have been considered but are not persuasive. The system of Appelt teaches a computer system scans the electronic document (Appelt, col. 8, lines 30-41). It is unclear to the examiner how to scan the display device. Therefore, the examiner interprets the scanner scans the electronic document, not the display device. Clearly, the system of Appelt has display and scan capabilities. It clearly can scan electronic document displayed on the display device.

6. As per applicant's arguments regarding claim 25 and 35, the Appelt reference fails to disclose "a user interface for initiating communication with the identified person via at least one communication access point", have been considered but are not persuasive. The system of Appelt uses computer connected to Internet, which obvious include a user interface.

Art Unit: 2172

Furthermore, Appelt disclose identify person and location (Appelt, col. 9, lines 19-20). The location is a communication access point related to the person. A computer connected to Internet clearly can initiate a communication with the identified person via the communication access point (location).

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, claim 10 and 12 are rejected based on the obviousness of Appelt. The system of Appelt uses a computer connected to Internet. A computer obviously can play sound and display information and provide audible (sound) and visible (display) alert.

8. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, claim 16-23, 31-34 and 46-49 are rejected based on Appelt in view of Appelman. Appelt disclose using a computer to parse an electronic document and identify a person and his/her location. The system of Appelt is connected to Internet. Appelman disclose an online

Art Unit: 2172

status field indicating whether the person is online. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the online status field of Appelman in the system of Appelt so that the system can identify whether the identified person is online. If the person is online, the user can contact the identified person.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-9, 11, 13-15, 24-30, 35-45 and 50 are rejected under 35 U.S.C. 102(e) as being anticipated by Appelt et al. ("Appelt", 6,601,026).

As per claim 1, Appelt teaches a system for automatically alerting a user to available information comprising:

parsing an electronic document, said electronic documents including any of a word processor document an Internet Web page, a spreadsheet, any textual and graphical data rendered on a display device, to identify data representing any person (Appelt, col. 5, lines 37-43);

identifying at least one person represented by the identified data (Appelt, Fig. 3, col. 5, lines 37-43, the information extraction engine 108 *parses* free-text documents to *identify* topics and objects (*people, ...*), col. 9, lines 15-21);

Art Unit: 2172

retrieving information relating to each identified person from at least one electronic database (Appelt, Fig. 1, 120, user queries, col. 11, lines 14-49); and

notifying the user that the retrieved information is available (Appelt, Fig. 5, 408, Send response to user).

As per claim 2, Appelt teaches all the claimed subject matters as discussed in claim 1, and further teaches providing at least one communication access point (Appelt, Fig. 12).

As per claim 3, Appelt teaches all the claimed subject matters as discussed in claim 2, and further teaches communication access point provides the user with an access point for initiating communication with each identified person (Appelt, col. 12, lines 48 - 67).

As per claim 4, Appelt teaches all the claimed subject matters as discussed in claim 3, and further teaches the at least one access point for initiating communication includes any of an email address, an instant messaging account, a telephone number, a fax number, a physical address, and an Internet address for communicating with the identified person (Appelt, Fig. 12, col. 12, lines 48-67, system have internet address in order to connect to internet).

As per claim 5, Appelt teaches all the claimed subject matters as discussed in claim 1, and further teaches parsing an electronic document to identify data representing any person comprises identifying textual data associated with any person (Appelt, Fig. 3, col. 5, lines 37-43).

As per claim 6, Appelt teaches all the claimed subject matters as discussed in claim 1, and further teaches the textual data associated with any person includes any of: a name, an email address, a telephone number, a fax number, and a social security number (Appelt, Fig. 3, col. 5, lines 37-43, col. 10, lines 6-11).

Art Unit: 2172

As per claim 7, Appelt teaches all the claimed subject matters as discussed in claim 1, and further teaches identifying graphical data associated with any person (Appelt, col. 5, lines 13-18, multimedia source).

As per claim 8, Appelt teaches all the claimed subject matters as discussed in claim 7, and further teaches identifying graphical data associated with any person (Appelt, col. 5, lines 13-18).

As per claim 9, Appelt teaches all the claimed subject matters as discussed in claim 1, and further teaches comparing the identified data to information in at least one electronic database (Appelt, Fig. 5 & 6, col. 11, lines 14-49).

As per claim 11, Appelt teaches all the claimed subject matters as discussed in claim 1, and further teaches providing a visible alert when the information is retrieved (Appelt, Fig. 12, Display, col. 11, lines 38-49).

As per claim 13, Appelt teaches all the claimed subject matters as discussed in claim 11, and further teaches modifying the appearance of the electronic document (Appelt, col. 11, lines 38-49).

As per claim 14, Appelt teaches all the claimed subject matters as discussed in claim 13, and further teaches changing the appearance of the identified data (Appelt, col. 11, lines 38-49).

As per claim 15, Appelt teaches all the claimed subject matters as discussed in claim 14, and further teaches associating at least one hyperlink with the identified data (Appelt, col. 11, lines 38-49).

As per claim 24, Appelt teaches a computer-implemented process for automatically providing information on a computer display device, comprising:



scanning electronic data being rendered on the computer display device to identify information within the electronic data that represents at least one person (Appelt, col. 5, lines 37-43);

identifying each person represented by the identified information (Appelt, Fig. 3, col. 5, lines 37-43, the information extraction engine 108 *parses* free-text documents to *identify* topics and objects (*people, ...*), col. 9, lines 15-21);

retrieving information relating to each identified person from at least one electronic database (Appelt, Fig. 1, 120, user queries, col. 11, lines 14-49); and

providing an alert for indicating that the retrieved information is available (Appelt, Fig. 5, 408, Send response to user).

As per claim 25, Appelt teaches all the claimed subject matters as discussed in claim 24, and further teach viewing the retrieved information; and initiating communications with the identified person via at least one communication access point (Appelt, Fig. 1, 12).

Claims 26-28 are rejected on grounds corresponding to the reasons given above for claims 13-15.

As per claim 29, Appelt teaches all the claimed subject matters as discussed in claim 26, and further teaches changing the appearance of graphical information representing the identified information (Appelt, col. 11, lines 38-49).

As per claim 30, Appelt teaches all the claimed subject matters as discussed in claim 29, and further teaches associating at least one hyperlink (Appelt, col. 11, lines 38-49).

As per claim 35, Appelt teaches all the claimed subject matters as discussed in claim 24, and further teaches communication access point for initiating communications with each identified person (Appelt, Fig. 12).

As per claim 36, Appelt teaches all the claimed subject matters as discussed in claim 24, and further teaches comparing the identified information to data in at least one electronic database (Appelt, Fig. 5 & 6, col. 11, lines 14-49).

As per claim 37, Appelt teaches a computer-readable medium having computer executable instructions for dynamically modifying an electronic document rendered on a computer display device, said computer executable instructions comprising:

detecting any information in the electronic document that represents at least one person (Appelt, col. 5, lines 37-43);

identifying each person based on a comparison of the detected information to data in at least one electronic database (Appelt, Fig. 3, 5 & 6, col. 5, lines 37-43, col. 8, lines 8-55);

retrieving data related to each identified person from at least one electronic database (Appelt, Fig. 1, 120, user queries, col. 11, lines 14-49); and

dynamically modifying the electronic document by changing the appearance of the electronic document for alerting a user that data related to each identified person has been retrieved (Appelt, Fig. 5, 408, Send response to user, col. 11, lines 38-49).

As per claim 38, Appelt teaches all the claimed subject matters as discussed in claim 37, and further teaches identifying any data associated with any person (Appelt, col. 5, lines 37-43, col. 10, lines 6-11).

As per claim 39, Appelt teaches all the claimed subject matters as discussed in claim 38, and further teaches identifying characteristics of at least one image within the electronic document using at least one image recognition technique (Appelt, col. 5, lines 13-18).

As per claim 40, Appelt teaches all the claimed subject matters as discussed in claim 37, and further teaches retrieving any of personal data and contact information from the at least one electronic database (Appelt, Fig. 5).

As per claim 41, Appelt teaches all the claimed subject matters as discussed in claim 37, and further teaches changing the appearance of any text associated with the detected information (Appelt, col. 11, lines 38-49).

As per claim 42, Appelt teaches all the claimed subject matters as discussed in claim 41, and further teaches associating at least one hyperlink with the text associated with the detected information (Appelt, col. 11, lines 38-49).

As per claim 43, Appelt teaches all the claimed subject matters as discussed in claim 42, and further teaches hyperlink includes at least one link to the retrieved data (Appelt, col. 11, lines 38-49).

As per claim 44, Appelt teaches all the claimed subject matters as discussed in claim 43, and further teaches communication access point (Appelt, Fig. 12).

As per claim 45, Appelt teaches all the claimed subject matters as discussed in claim 37, and further teach changing the appearance of any image associated with the detected information and by associating at least one hyperlink with each image (Appelt, col. 11, lines 38-49).

As per claim 50, Appelt teaches all the claimed subject matters as discussed in claim 37, and further teaches a user interface for interacting with the retrieved data (Appelt, Fig. 1).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelt et al ("Appelt", 6,601,026).

As per claim 10, Appelt teaches all the claimed subject matters as discussed in claim 1, except for explicitly disclosing providing an audible alert when the information is retrieved. However, the computer system disclosed by Appelt has speakers (Appelt, col. 13, lines 1-2), therefore, the computer system has the capability to provide an audible alert. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an audible alert in order to notify the user the information is retrieved.

As per claim 12, Appelt teaches all the claimed subject matters as discussed in claim 1, and further teaches providing a visible alert when the information is retrieved (Appelt, Fig. 12, Display, col. 11, lines 38-49). Appelt does not explicitly teach providing an audible alert when the information is retrieved. However, the computer system disclosed by Appelt has speakers (Appelt, col. 13, lines 1-2), therefore, the computer system has the capability to provide an audible alert. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an audible alert in order to notify the user the information is retrieved.

13. Claims 16-23, 31-34 and 46-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appelt et al. ("Appelt", 6,601,026) in view of Appelman et al. ("Appelman", 6,539,421).

As per claim 16, Appelt teaches all the claimed subject matters as discussed in claim 11, except for explicitly disclosing adding at least one presence indicator. Appelman teaches online status indicator (Appelman, col. 5, lines 52-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Appelman with Appelt in order to notify the user about the online status of the identified person.

As per claim 17, Appelt and Appelman teach all the claimed subject matters as discussed in claim 16, and further teach determining an online status for each identified person by querying at least one messaging account server for each identified person (Appelman, col. 5, lines 43-65).

As per claim 18, Appelt and Appelman teach all the claimed subject matters as discussed in claim 17, and further teach each presence indicator graphically represents the online status of each identified person (Appelman, col. 5, lines 43-65).

As per claim 19, Appelt and Appelman teach all the claimed subject matters as discussed in claim 18, except for explicitly disclosing the graphical representation of the online status of each identified person is automatically updated by re-querying the at least one messaging account server for each identified person. However, any person has used instant message knows the online/offline status is a live status, when a buddy goes online or offline, the online status will be automatically updated. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to automatically update the online status of each identified person by re-querying the at least one messaging account server in order to display the identified person's current online status.

As per claim 20, Appelt and Appelman teach all the claimed subject matters as discussed in claim 1, and further teach a graphical user interface for interacting with the retrieved information (Appelman, Fig. 3).

As per claim 21, Appelt and Appelman teach all the claimed subject matters as discussed in claim 20, and further teach the graphical user interface comprises at least one pop-up window for displaying the retrieved information for each identified person (Appelman, Fig. 5).

As per claim 22, Appelt and Appelman teach all the claimed subject matters as discussed in claim 20, and further teach the graphical user interface comprises at least one context-sensitive menu for interacting with the retrieved information for each identified person (Appelman, Fig. 3, 5).

As per claim 23, Appelt and Appelman teach all the claimed subject matters as discussed in claim 20, and further teach the graphical user interface comprises at least one hyperlink for accessing the retrieved information for each identified person via a computer pointing device (Appelman, Fig. 3-5).

As per claim 31, Appelt teaches all the claimed subject matters as discussed in claim 26, except for explicitly disclosing adding at least one presence indicator to the electronic data. Appelman teaches online status indicator (Appelman, col. 5, lines 52-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Appelman with Appelt in order to notify the user about the online status of the identified person.

As per claim 32, Appelt and Appelman teach all the claimed subject matters as discussed in claim 31, and further teach an associated pop-up window for providing the retrieved information to a user (Appelman, Fig. 3-5).

As per claim 33, Appelt and Appelman teach all the claimed subject matters as discussed in claim 31, and further teach an associated context-sensitive menu for providing the retrieved information to a user (Appelman, Fig. 5).

As per claim 34, Appelt and Appelman teach all the claimed subject matters as discussed in claim 31, and further teach indicating an online status of each identified person (Appelman, Fig. 3-5, col. 5, lines 52-54).

Claims 46-49 are rejected on grounds corresponding to the reasons given above for claims 31-34.

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2172

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

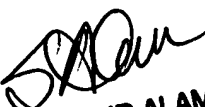
***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chongshan Chen whose telephone number is 703-305-8319. The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703)305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 29, 2004

  
SHAHID ALAM  
PRIMARY EXAMINER